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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,337	02/13/2001	Natarajan S. Ramesh	CSAC-0009	9820

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CRYOVAC, INC.
SEALED AIR CORP
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EXAMINER

ROCHE, LEANNA M

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 02/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

A 210

Office Action Summary

Application No.

09/782,337

Applicant(s)

RAMESH ET AL.

Examiner

Leanna Roche

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 24-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 28-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 23 December 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's amendments filed December 23, 2002 have been entered and carefully considered. Claims 28-31 have been added. Claims 24-27 remain withdrawn from consideration. Thus, Claims 1-23 and 28-31 are pending for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-12, 15-23 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akao (USPN 4469741) in view of Foster (USPN 5968630) substantially as set forth in Paper No. 6, paragraphs 9-10.

With regard to newly added Claim 28, it is the examiner's position that the laminated sheets of Akao in view of Foster are identical to or only slightly different than the composite material prepared by the method of the claim(s), because both are comprised of a polyolefin foam sheet sandwiched between a first film and a second film, the second film having one edge extending beyond a corresponding edge of the foam sheet, and as disclosed in Foster it is known in the art that polyethylene films and polyethylene foams can be laminated together by the use of heat and/or adhesive (Foster, Column 8, lines 21-27). Therefore, even though product-by-process claims are

limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). The laminated sheets of Akao in view of Foster either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Akao in view of Foster.

4. Claims 1-23 and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foster (USPN 5968630) in view of Deibel et al. (USPN 6358599), substantially as set forth in Paper No. 6, paragraphs 11.

With regard to newly added Claim 28, Foster teaches that a polyethylene film and polyethylene foam sheet can be laminated together by use of heat and/or adhesive (Column 8, lines 21-27). This reads on Applicant's films heat laminated to the foam sheet. With regard to Claim 29, Foster discloses the use of a film layer that has orientation in both directions (Column 6 line 65 - Column 7 line 14). This reads on

Applicant's films stretch oriented in at least two directions. With regard to claims 30 and 31, Foster teaches applying a double-sided adhesive tape to the extended edge of the film sheet of their film/foam laminate to adhere adjacent film/foam laminate strips so that they are completely non-movable in relation to one another, and Foster teaches applying a removable layer to the top of the double-sided adhesive tape to prevent the film/foam laminate from sticking to itself during manufacture.

Response to Arguments

5. Applicant's proposed drawing correction and discussion are sufficient overcome the objection to the drawings set forth in Paper No. 6, paragraph 7.

6. Applicant's arguments with regard to the definition of the term "orientation ratio" as disclosed in Applicant's specification are sufficient to overcome the objection to Claim 14 set forth in Paper No. 6, paragraph 8.

Akao in view of Foster

7. Applicant specifically argues that Akao "makes no mention of water vapor transmission, and does not suggest that vapor barrier characteristics (improved or not) are exhibited by the sheet described therein". This argument is not found persuasive of patentability because it is noted that the features upon which applicant relies (i.e., vapor barrier characteristics or moisture resistance) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8. Applicant contends, "the Akao material does not have a film sheet that extends beyond a corresponding edge of the foam sheet". This argument is not found persuasive of patentability because Akao was not relied on to show an extended edge. Foster shows an extended edge and provides motivation necessary to show why it would be obvious to use an extended edge in the Akao material.
9. Applicant contends, "While a bonding material may be used to adhere the film to a foam, it is not required by the present invention". This argument is not found persuasive because Applicant's claim incorporates "comprising" language which reads on Applicant's composite material having any number of additional layers. Additionally, Applicant's own argument admits that their claim reads on a film adhered to a foam using a bonding material.
10. With regard to Applicant's argument that Akao "states that heat bonding is not desirable, thus teaching away from the preferred embodiment of the present invention", this statement is not found persuasive of patentability because obviousness may exist although teachings relied upon may be disclosed in art as non-preferred or unsatisfactory for intended purposes. *In re Hans Theodor Boe* teaches, "

All of the disclosures in a reference must be evaluated for what they fairly teach one of ordinary skill in the art. Thus, in *In re Smith*, 32 CCPA 959, 148 F.2d 351, 65 USPQ 167; in *In re Nehrenberg*, 47 CCPA 1159, 250 F.2d 161, 126 USPQ 383; and in *In re Watanabe*, 50 CCPA 1175, 315 F.2d 924, 137 USPQ 350, this court affirmed rejections based on art which we concluded rendered the claimed invention obvious to those of ordinary skill in the art despite the fact that the art teachings relied upon in all three case were phrased in terms of a non-preferred embodiment or as being unsatisfactory for the intended purpose.

It is also important to note that the discussion in Akao that is contrary to heat laminating is directed to an embodiment which incorporates directly laminating two films together. Akao was not relied on to show that two film layers may be laminated together directly, but rather to show a film adhered to a porous material adhered to a film. Foster provides ample evidence that heat laminating films to foams may be equally used in place of laminating a film and foam via an adhesive layer. Finally, the limitation of heat lamination is a process limitation, and therefore the burden is on Applicant to show unobvious differences between the claimed product and the prior art product.

11. Applicant argues “in the present invention...no specific molecular orientation is required for the films, and biaxially stretch-oriented films are preferred”. This is not found persuasive of patentability because Akao was not relied on to show “biaxially stretch-oriented films”, and Applicant’s claims are directed to **generic** first and second films which would automatically encompass the films of Akao.

12. Applicant argues that Foster does not remedy the deficiencies of Akao because Foster “does not disclose or suggest the use of a second film layer adhered to the opposite side of the foam layer”. This argument is not found persuasive of patentability because Foster was not relied upon to disclose a second film layer adhered to the opposite side of the foam layer. Additionally, the examiner did not attempt to modify Foster to have a second film layer because Foster is a secondary reference used to show motivation for modifying the primary reference, Akao.

13. Overall, in response to Applicant's arguments against Akao and Foster individually, one cannot show nonobviousness by attacking references individually

where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Foster in view of Deibel

14. Applicant contends that Foster “does not disclose or suggest the use of a second film adjacent to the opposite surface of the foam”. This argument is not found persuasive of patentability because as thoroughly disclosed in the previous rejection, Foster was not relied upon to show a second film adjacent to the opposite side of the foam.

15. With regard to Applicant’s arguments that “Foster’s stated desire to reduce costs teaches away from the addition of a second film layer”, Applicant is directed to the full phrase of Column 2, lines 2-7 where Foster states

An object of the invention is to provide a laminated composition of polyethylene foam sheet and polyethylene film used in the installation of laminate wood floors to provide a vapor-barrier, some cushioning, smoothing out of small surface irregularities of the concrete, cost savings and increased ease and efficiency of installation.

It is clear that Foster intends to use their laminated composition to provide cost savings in the installation of laminated wood floors. Foster does not disclose any indication that an additional film layer would reduce their installation cost savings. Therefore, although an additional film layer would increase the overall cost of the laminate composition of Foster, Deibel was relied upon to show motivation for adding an additional film layer, and Deibel provides sufficient motivation for adding an additional film layer.

16. Applicant argues, "Deibel does not state that biaxially oriented polyolefin films are suitable for the invention claimed therein". This argument is not found persuasive because while Deibel does disclose disadvantages for using biaxially oriented polyolefin films, Deibel also describes that it is well known in the art of insulative laminate compositions to use two outer layers of biaxially oriented polyolefin films, and Deibel also provides motivation for using two outer layers of biaxially oriented polyolefin films, i.e. enhanced strength and resistance to breaking. Therefore, because obviousness may exist although teachings relied upon may be disclosed in art as non-preferred or unsatisfactory for intended purposes, Deibel provides suitable motivation for modifying the laminate composition of Foster to have a second film layer. As discussed before, all of the disclosures in a reference must be evaluated for what they fairly teach one of ordinary skill in the art (*In re Smith*, 32 CCPA 959, 148 F.2d 351, 65 USPQ 167; *In re Nehrenberg*, 47 CCPA 1159, 250 F.2d 161, 126 USPQ 383; *In re Watanabe*, 50 CCPA 1175, 315 F.2d 924, 137 USPQ 350). The court has affirmed rejections based on art which they concluded rendered the claimed invention obvious to those of ordinary skill in the art despite the fact that the art teachings relied upon in all three case were phrased in terms of a non-preferred embodiment or as being unsatisfactory for the intended purpose.

17. Again, in response to applicant's arguments against Foster and Deibel individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642

F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

18. Applicant's amendments necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

19. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

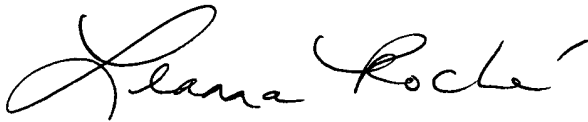
Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leanna Roche whose telephone number is 703-308-6549. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm (with alternate Mondays off).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



lmr
February 12, 2003



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